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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,653	11/28/2000	Victor Ling	APZ-004	7709

500 7590 03/08/2004

SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 6300
SEATTLE, WA 98104-7092

EXAMINER

RAO, MANJUNATH N

ART UNIT PAPER NUMBER

1652

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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20040211

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

In view of the papers filed 12-9-03, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by addition of inventors,


ENTERED IN DOCKET


Michelle L. POLLARD, Bruce P. CONNOP and Fang ZHANG.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The examiner can normally be reached on 6.30 a.m. to 3.00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0939. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Manjunath N. Rao
February 10, 2004


CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600


Manjunath N. Rao, Ph.D.
Primary Examiner
Art Unit: 1652

Mae Rosok

From: Mae Rosok
Sent: Monday, October 13, 2003 11:49 AM
To: 'fzhang'
Subject: RE: inventorship

Dear Dr. Zhang,

Inventorship is an issue that is constantly reviewed by applicants and their attorneys during prosecution and examination of a parent application and its related descendent applications. While applicants and their counsel make good efforts at the time of filing an application to identify and to name correctly all the inventors, omissions, as well as incorrect additions, in inventorship do occur. We were prompted to inquire about inventorship for this matter when we identified the publication on which you were first author. Many of us who are familiar with academic labs and how authorship of publications is determined understood that the first author (especially a post-doctoral candidate) may have played a significant role in the scientific project. Although, as we have discussed, determining inventorship requires a legal analysis, the publication indicated that inquiry into this matter was warranted. Our law firm did not represent Active Pass at the time this application was filed; therefore, we do not know what discussions relating to inventorship took place at the time of filing. Not unusual to patent practice, this case was transferred to our office 1-2 years after filing. While we cannot go back in time to the date this application was filed to discuss inventorship with you, we can review and correct inventorship if an error has been made.

Assuming that I am understanding your question correctly, I think part of the explanation comes from how the Patent and Trademark Office (PTO) operates. This application, as you note, was filed three years ago but the allowance of the claims that we forwarded to you resulted from the first examination by the PTO of this application. Because of the volume of patent applications that the PTO must handle, an application may "wait in line" to be processed for 18 months or even longer than 2 years. The original application (also called the parent application) included numerous claims; however, under U.S. patent practice, called restriction practice, only a subset is likely to be examined at one time. The patent examiners at the PTO often require restriction of claims within an application, such as this one, into separate groups. Examples of the groups include a group relating to polynucleotides; another group relating to polypeptides; and other groups relating to particular methods. The applicants may choose which set of claims to have examined first, and in this case, Active Pass chose the polynucleotide related claims for prosecution in this parent application.

The claims define the invention, and inventorship is determined according to the particular claims. Because of U.S. restriction practice, applicants continue to have groups of claims examined, and each group will issue as a separate patent that descends from and is related to the parent application. Sometimes this will also result in different named inventors on the different related applications because different people have contributed to different aspects of the invention. Another possible situation is that during prosecution, claims are amended in conformance with the text of the specification, and this leads to introduction of subject matter not recited in the claims as originally filed. A person not named on an original application may very well need to be added as an inventor in view of particular amendments. As you can see this is a fairly dynamic process, and accordingly, we continually make good faith efforts to correctly name the inventors on each patent.

I hope that my comments have been helpful. Please contact me again if you have any additional questions.

Best Regards,
Mae

Mae Joanne Rosok
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701 Fifth Avenue, Suite 6300

Seattle, WA 98104
Phone: 206-622-4900
Facsimile: 206-682-6031
maer@seedlaw.com

-----Original Message-----

From: fzhang [mailto:fzhang@uvic.ca]
Sent: Friday, October 10, 2003 6:16 PM
To: Mae Rosok
Subject: RE: inventorship

Hello Ms Rosok:
I have recieved the Package you sent to me.

In the original ABCB-9 patent aplication (three years ago), I was not an inventor. If I do not sign a document which made a correction from that I was not an inventor to be an inventor, why I should sign this correction now?

Thank you for your attention

Fang Zhang

Mae Rosok

From: Mae Rosok
Sent: Wednesday, October 22, 2003 9:55 AM
To: 'fzhang'
Subject: RE: inventorship

Dear Dr. Zhang,

You are correct that the documents that we sent to you are to correct inventorship and to add you as an inventor to this application. While some of the allowed claims are directed to the polynucleotide sequence only, other claims, particularly claims 25 and 26 and related dependent claims, are directed to the polynucleotide wherein the encoded ABCB9 transporter retains an ABCB9 transporter activity. Even if you had no involvement with reading or interpreting the nucleotide sequence, this functional definition relates to the contributions that you made to this invention.

As I noted in my letter, you may choose not to participate and be a non-signing inventor; however, as a matter of law, your contributions appear to meet the criteria for inventorship and you will be added to this application as an inventor. If you are concerned that being a named inventor on this application has effects that I am not appreciating, please feel free to discuss them with me. Also, Peter Reiner of Active Pass is very willing to speak with you about any concerns that you may have.

Thank you for your time.

Best Regards,

Mae

Mae Joanne Rosok
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 Seattle, WA 98104
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 Facsimile: 206-682-6031
 maer@seedlaw.com

-----Original Message-----

From: fzhang [mailto:fzhang@uvic.ca]
Sent: Tuesday, October 21, 2003 7:09 PM
To: Mae Rosok
Subject: RE: inventorship

Hello Ms Rosok:

Thank you very much for your replying my e.mail. There was a misunderstanding on my part when I received your package: with a quick glimpse of your letter, I thought that I was asked me to sign off the inventorship. That was why I wrote to you that E.mail: I was asking if I have not signed for the correction to make me an inventor, why I need to sign off the inventorship.

When I read the Statement you prepared for me to sign, I realize that you in fact ask me to sign for the correction to make me an inventor. This is the exact action I do not want to do. If you recall our last phone conversation, I am not an inventor, I do not think there is any inventorship error in the original patent application. The patent application is the polynucleotide sequence of ABCB9 gene. Dr Wandong Zhang, Cynthia Fisher, and Lin Liu did the work on sequencing and DNA sequence analysis. The publication on the ABCB9 gene you referred is mainly on the characterization of the gene product-ABCB9 protein; the gene sequence is very small portion in the paper. Because I did most work on the protein characterization, I was the first author of the paper. Had a paper published on the polynucleotide sequence of ABCB9 gene, I would have not been the first author. I do not know how I can make myself clearer that I am not be part of the patent.

fang

Mae Rosok

From: Mae Rosok
Sent: Wednesday, November 12, 2003 10:36 AM
To: 'fzhang@uvic.ca'
Subject: PTO documents

Dear Dr. Zhang,

If you would kindly inform me by return email if you have decided not to sign the documents that we forwarded to you on October 6, 2003 or if we might expect to receive the signed documents from you in the near future, preferably by November 24, 2003. If you choose to sign the documents, please also provide us with documentation of any associated expenses, such as the cost of a notary, so that you may be reimbursed. Please do not hesitate to contact me if you have any questions.

Regards,
Mae

Mae Joanne Rosok
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Phone: 206-622-4900
Facsimile: 206-682-6031
maer@seedlaw.com

Mae Rosok

From: fzhang [fzhang@uvic.ca]
Sent: Thursday, November 13, 2003 9:34 AM
To: Mae Rosok
Subject: RE: PTO documents

Dear Ms Rosok

I am not going to change the decision I have made. Thank you for your patience.

Best Wishes

Fang